



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/752,524	01/03/2001	Kazuyuki Nishi	44084-484	9990

7590 05/05/2004  
MCDERMOTT, WILL & EMERY  
600 13th Street, N.W.  
WASHINGTON, DC 20005-3096

EXAMINER
----------

KORNAKOV, MICHAIL

ART UNIT	PAPER NUMBER
----------	--------------

1746

DATE MAILED: 05/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/752,524

Applicant(s)

NISHI, KAZUYUKI

Examiner

Michael Kornakov

Art Unit

1746

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 April 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.  
2. ☒ The proposed amendment(s) will not be entered because:  
(a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ they raise the issue of new matter (see Note below);  
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
5. ☒ The a) ☒ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.  
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.  
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1,4-8,11 and 14.

Claim(s) withdrawn from consideration: 2,3,9,10,12,13 and 15-18.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.  
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.  
10. ☐ Other: \_\_\_\_\_

05/03/04 M. KORNAKOV  
AU 1746

Continuation of 2. NOTE: Although the proposed alcohol was initially present in claim 7, which is now proposed to cancel, however, if entered in claim 1 it will remove claim 1 from the scope of 35 USC 102 rejection, will change the scope of all claims that depend on the instant claim1, and will thus require new consideration, and/or new search.

Continuation of 5. does NOT place the application in condition for allowance because: a) the argument with regard to the claims previously rejected under 35 USC 102 is based on the proposed amendment that has not been entered; b) with regard to an obviousness rejection, Applicants argue that the process of the instant claims is novel because of the introduction of the intermediate step in the washing process. MPEP 710.02 (e). If affidavit is submitted after final rejection, examiner is questioning why such affidavit is now necessary and why it was not earlier presented. Applicants have not shown why the affidavit was not earlier presented, therefore, the entry of the Affidavit is denied. Implicit in the above practice is the fact that affidavits submitted after final rejection are subject to the same treatment as amendments submitted after final rejection. In re Affidavit Filed After Final Rejection, 152 USPQ 292 (Comm'r Pat. 1966). Failure to file a reply during the shortened statutory period results in abandonment of the application.

Examiner is still in the position that the prima facie case of obviousness has been established for claims 7 and 8 as per reasons set forth in the Final rejection.